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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,431	04/02/2007	Virginie Pevere	1022702-000324	1081

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BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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NWAONICHA, CHUKWUMA O

ART UNIT	PAPER NUMBER
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1621

NOTIFICATION DATE	DELIVERY MODE
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02/24/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/582,431	<b>Applicant(s)</b> PEVERE ET AL.	
	<b>Examiner</b> CHUKWUMA O. NWAONICHA	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3 December 2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

**Current Status**

1. Claims 15-28 are under active consideration in the instant application.

**Lack of Unity**

Applicant's election with traverse of Group 1 (claims 15-24) in the reply filed on 3 December 2008 is acknowledged.

The traversal is on the ground(s) that claims 15-28 are related as a single invention. The inventions of Groups 1 and 2 are independent and patentably distinct because there is no patentable co-action among the ten groups and a reference anticipating one member will not render the other obvious. Group 1 is drawn to a process for preparing an organodialkylalkoxysilane of the general formula III while Group 2 is drawn to a process for preparing an organodialkylalkoxysilane of the general formula IV. These are two different inventions and require different search strategies that will impose an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made **FINAL**. Group 2 (claims 25-28) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups, there being no allowable generic or linking claim. All claims consisting of Group 1 (claims 1-6 and 8-16) drawn to a compound and a method of manufacturing a compound, will be examined on the merits. Applicants are reminded of their right to file divisional applications to the non-elected claims.

Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

#### ***Claim Objection***

Claims 15-28 are objected to because of the following informalities: claim 15 contains flow diagrams. Appropriate corrections are required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims (claims 15-24) are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English

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from a foreign document and are replete with grammatical and idiomatic errors. For example, the claims recite "detachable" instead of leaving group. The entire claims are not clear and appropriate corrections are required.

Claims 15-24 are indefinite because of the symbol "+". It is not unclear what Applicants are trying to claim. Clarification is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim** 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Guenouni et al., {WO 03/048169}.

Applicants claim a process for preparing an organodialkylalkoxysilane of the general formula III;



Formula III.

The process comprising reacting the compound of formula 2 with the compound of formula 3 in the presence of organic solvents; wherein the variable variables are as defined in the claims.



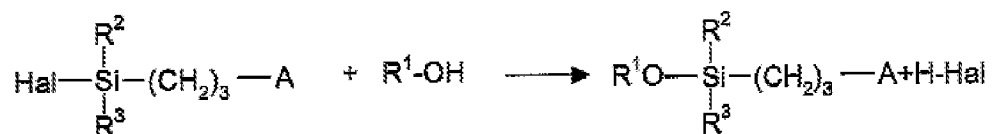
Formula 2



Formula 3

**Determination of the scope and content of the prior art (M.P.E.P. §2141.01)**

Guenouni et al. (1) teach a process for preparing an organodialkylalkoxysilane comprises an alcoholysis reaction of an alcohol and halosilane compound in an organic solvent under reflux condition as shown below. See pages 7, 22 and 29.



**Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)**

Guenouni et al. process for producing organodialkylalkoxysilane differs from the instantly claimed process in that Applicants' recite the manner of introduction of the alcohol to prevent the accumulation of the halo acid generated during the reaction while Guenouni et al. are silent about the recitation of this phrase.

**Finding of prima facie obviousness--rational and motivation (M.P.E.P. §2142-2143)**

The instant claimed process for producing organodialkylalkoxysilane is obvious over the prior art reference of Guennouni et al. because the reference teach a process of employing OH functional compound and halo silane compound in the presence of an organic solvent to make an organodialkylalkoxysilane.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by following the process steps and conditions taught by Guennouni et al. to arrive at the instantly claimed process for making organodialkylalkoxysilane. Said person would have been motivated to practice the teaching of the references cited because they demonstrate that organodialkylalkoxysilanes have industrial applications. The Examiner notes that simply reversing the order of steps in a multi-step process is not a patentable modification **absent** unexpected or unobvious results. Ex parte Rubin, 128 U.S.P.Q. 440 (P.O.B.A 1959). Thus, the variation of the process conditions in the production of organodialkylalkoxysilane is not a patentable distinction because Guennouni et al. teach the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be *prima facie* obvious to one of ordinary skill in the art.

Moreover, all the claimed elements (OH functional compound, halo silane, organic solvents concentration, and reactants and product ratio) were known in the prior art and one skilled in the art could have combined the elements as claimed by known

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methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chukwuma O. Nwaonicha/  
Examiner, Art Unit 1621

/Jafar Parsa/  
Primary Examiner, Art Unit 1621